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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,248	10/13/2004	William K. S. Cleveland	3238-01	8874
26645 7590 07/06/2010 THE LUBRIZOL CORPORATION ATTN: DOCKET CLERK, PATENT DEPT. 29400 LAKELAND BLVD. WICKLIFFE, OH 44092				
EXAMINER				
VASISTH, VISHAL V				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
07/06/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/511,248

**Applicant(s)**

CLEVELAND ET AL.

**Examiner**

VISHAL VASISTH

**Art Unit**

1797

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5-8,10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-8,10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicants' response filed 4/14/2010 amended independent claim 1 and cancelled claims 9 and 16-20. Applicants' amendments overcome the claim objections from the office action mailed on 1/29/2010 and the 35 USC 103 rejections over Blythe in view of Patel, therefore these objections and rejections are withdrawn. Neither applicants' arguments nor amendments addressed below overcome the 35 USC 103 rejection over Blythe in view of Patel further in view of Teacherson from the office action mailed on 1/29/2010, therefore this rejection is maintained below and incorporated herein by reference.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 3, 5-8, 10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blythe, US Patent No. 5,264,005 (hereinafter referred to as Blythe) in view of Patel et al., US Patent No. 5,741,764 (hereinafter referred to as Patel) further in view of Teacherson, US Patent Application Publication No. 2004/0083729 (hereinafter referred to as Teacherson).

The rejection from Paragraph 6 of office action mailed on 1/29/2010 is maintained and incorporated herein by reference.

### ***Response to Arguments***

5. Applicants' arguments filed 4/14/2010 regarding claims 1, 3, 5-8, 10 and 12-14 have been considered and are not persuasive.

Applicants argue that the amendments to independent claim 1 are sufficient to demonstrate that the claims are now commensurate in scope with the data from the specification and the data presented in the Declaration signed by Laimute Svarcas on 12/16/2009 and that this data demonstrates that the example oil compositions show unexpected results.

Applicants point to MPEP §2145 where in pertinent part it reads that "a showing of unexpected results for a single member of a claimed subgenus , or a narrow portion of a claimed range would be sufficient . . . if a skilled artisan could ascertain a trend ." Looking at the data in order to ascertain a trend it was very difficult to find one across the full scope of concentrations. For example, in Examples G and H of Table 2 the same components were in both compositions except example G 1.3 wt% more Mannich

dispersant than Example H. This is critical because the Undercrown Rating fell from 6.3 to 5.2 from the change in Mannich dispersant concentration. In making a trend analysis one of ordinary skill in the art would reasonably assume that by adding more Mannich dispersant the Undercrown Rating gets worse. Furthermore, based on the claims as instantly recited – Example G could have up to 13 wt% of Mannich dispersant which by the trends discussed above would actually give the composition a subpar Undercrown Rating.

This is also important because when comparing Example G and Comparative example J it is shown by Table 2 that the difference in Undercrown Rating is only 0.1 and based on the trend discussed above it can be reasonably assumed that the rating would go down at 13 wt% of Mannich dispersant thereby causing a worse Undercrown Rating as well as worse Power Valve rating than comparative formulation J. Therefore, applicants' other argument that, "evidence that a composition possesses superior and unexpected properties in one of a spectrum of common properties can be sufficient to rebut a prima facie case of obviousness," is no longer a persuasive argument, because comparative example J would have better Undercrown and Piston Valve Ratings than Example G.

Applicants should also narrow the independent claims with a concentration for the (B)(3) friction modifiers that is commensurate in scope with the data provided. It is plain to see from Table 2 that without any friction modifier that the results are very poor and 0.1 ppm is essentially no friction modifier. Furthermore, it can also be seen from the data in Table 2 that a difference in 0.2 wt% of friction modifier demonstrates

excellent results as is seen when comparing Comparative examples A-D and Comparative Example F. Therefore, it may also be necessary for applicants to explain why different concentrations of friction modifier were used when different dispersants were used namely Mannich vs. aminophenol.

Finally, applicants should also narrow component B(1) to more accurately reflect the compound in the Tables of the instant specification or in the alternative make a statement as to why all compounds reading on this component would act in the same manner in this composition or at least show results for several compounds reading on this component to show that the compound itself does not matter.

The reasons stated above show that applicants have not demonstrated unexpected results across the full scope of the claims.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the

statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VVV

/Michael A Marcheschi/  
Supervisory Patent Examiner, Art  
Unit 1797